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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/516,621 Confirmation No. 5295

Applicant : Tatsuo TSUNEKA et al.

Filed : December 3, 2004

TC/A.U. : 1713

Examiner : William K. Cheung

Dkt. No. : SAE-036

Cust. No. : 20374

I hereby certify that this paper is being facsimile transmitted on June 21, 2006, to the United States Patent and Trademark Office to facsimile number (571)273-8300.

Ronald J. Kubovcik

COMMENTS RE ADVISORY ACTION DATED JUNE 5, 2006

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

June 21, 2006

Sir:

This paper is submitted in connection with the RCE of the subject application and submission under 37 C.F.R. § 1.114 filed on even date herewith.

The submission under 37 C.F.R. § 1.114 includes the request for reconsideration filed May 22, 2006, in response to the Final Action dated December 21, 2006, and the declaration under 1.132

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filed with the request for reconsideration. In an Advisory Action dated June 5, 2006, the request for reconsideration was held to not place the application in condition for allowance. The 132 declaration was not entered.

The reasons provided by the Office for holding that the request for reconsideration does not place the application in condition for allowance are as follows:

> "Applicants argue that claims 1-11 should be allowed because example No. 6 of [Ashihara] et al. requires forced emulsification to obtain an emulsion. However, applicants fail to recognize that the present claims do not exclude an aqueous resin dispersion composition prepared by a forced emulsification method. Further, applicants must recognize that the invention of claims 1-5 relates to an aqueous resin composition. As long as the composition of [Ashihara] et al. is substantially identical to that of claims 1-5 the rejection set forth is proper... Claims 6-11 stand rejected under [35 U.S.C.] 103... because claims 6-11 as written do not exclude a process involving a forced emulsification method."

However, these reasons do not properly characterize the arguments made in the request for reconsideration for removing the final rejections of the claims.

First, regarding claims 1-5, applicants argued that the composition defined in claims 1-5 is different from the product of Example 6 of Ashihara. The acid-modified chlorinated polyolefin in Example 6 of Ashihara is obtained by graft-polymerizing methacrylic acid (MAcA) and maleic anhydride (MAH) to a propylene-butene copolymer (PB) (Graft Polymerization 1), chlorinating the graft

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polymer to form an acid-modified chlorinated polyolefin, and further graft-polymerizing the acid-modified chlorinated polyolefin with maleic anhydride (MAH) and 2-ethylhexyl methacrylate (MAcEH) (Graft Polymerization 2). Since methacrylic acid (MAcA) and 2-ethylhexyl methacrylate (MAcEH) are polar monomers, the acid-modified chlorinated polyolefin obtained in Example 6 is highly polar and, therefore, can give an aqueous resin composition without using a surfactant (Ashihara, Col. 5, line 46, to Col. 6 line 12; and Col. 8, lines 6-24). The Office did not address this argument. Consideration of this argument is now in order.

Second, regarding claims 6-11, applicants noted that the Office had acknowledged that the process step sequences of Ashihara and of the process recited in claims 6-11 of the present invention are different, but had taken the position that "since applicant has not demonstrated the criticality of the process sequence, the selection of any order of performing process step is *prima facie* obvious in the absence of new or unexpected results" (page 6, third paragraph, of the Action).

To rebut the position of the Office, applicants submitted the 132 declaration which shows the criticality of the process sequence recited in claims 6-11. Specifically, Comparative Experiments 1 and 2 of the declaration show that when water is added to a

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solution of an acid-modified chlorinated polyolefin in an ethereal solvent before neutralization, it is impossible to obtain a dispersion (aqueous resin dispersion composition). In contrast, a dispersion (aqueous resin dispersion composition) can be obtained when water is added to a neutralized solution of an acid-modified chlorinated polyolefin in an ethereal solvent, as is shown in Examples 1 and 2 in the specification of the present application.

Applicants also explained that the Office had failed to properly show that Verardi teaches that an aromatic solvent and an ethereal solvent are functionally equivalent in a process for preparing an aqueous resin dispersion composition as disclosed in Ashihara. The description of Verardi cited by the Office, i.e., Col. 6, lines 42-58, describes only that both aromatic solvents and ethereal solvents can be used as a solvent for a solvent-based coating composition. Verardi does not disclose an equivalence of aromatic solvents and an ethereal solvents in a process for preparing an aqueous-based composition as disclosed in Ashihara.

Furthermore, applicants noted that Comparative Experiment 3 in the 132 declaration shows that the use of toluene as a solvent makes it impossible to obtain a dispersion (aqueous resin dispersion composition) even when water is added after neutralization.

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These arguments were apparently not considered because, as noted above, the Office did not enter the 132 declaration. Consideration of these arguments and the data of the 132 declaration will overcome the final rejection and is now in order.

Applicants did not argue that the process recited in claims 6-11 is patentable because the process does not include a forced emulsification. Thus, there is no need for claims 6-11 to exclude a process involving a forced emulsification method as suggested in the Advisory Action.

Removal of the 35 U.S.C. 103 rejections of claims 1 to 11 is in order and is respectfully requested.

In the event that any fees are required in connection with this paper, please charge our Deposit Account No. 111833.

Respectfully submitted,

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